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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,178	08/21/2001	Brian J. Brown	S63.2N-5605-US05	8077
490 7590 12/31/2007 VIDAS, ARRETT & STEINKRAUS, P.A. SUITE 400, 6640 SHADY OAK ROAD EDEN PRAIRIE, MN 55344			EXAMINER PREBILIC, PAUL B	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/934,178

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilic

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 10 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 13-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22 and 29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for angularly (see page 3, lines 6-7) or diagonally (see Figures 1 to 4) extending interconnecting elements, does not reasonably provide enablement for curved or perpendicular interconnecting elements. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In particular, the original specification only discloses straight diagonally extending interconnecting elements, yet the present claims set forth all non-parallel interconnecting elements as if that was originally contemplated. However, since any

non-parallel interconnecting element was not clearly enabled, the Examiner asserts that the scope of this term is not fully enabled.

Claim Objections

Claim 17 is objected to because of the following informalities:

On line 6 of claim 17, the language "the peaks of the proximal portion" lacks antecedent basis since the portions do not necessarily contain peaks.

On line 7 of claim 17, "the valleys" lacks antecedent basis for the same reason that "the peaks" lacks antecedent basis in line 6. Appropriate correction is required.

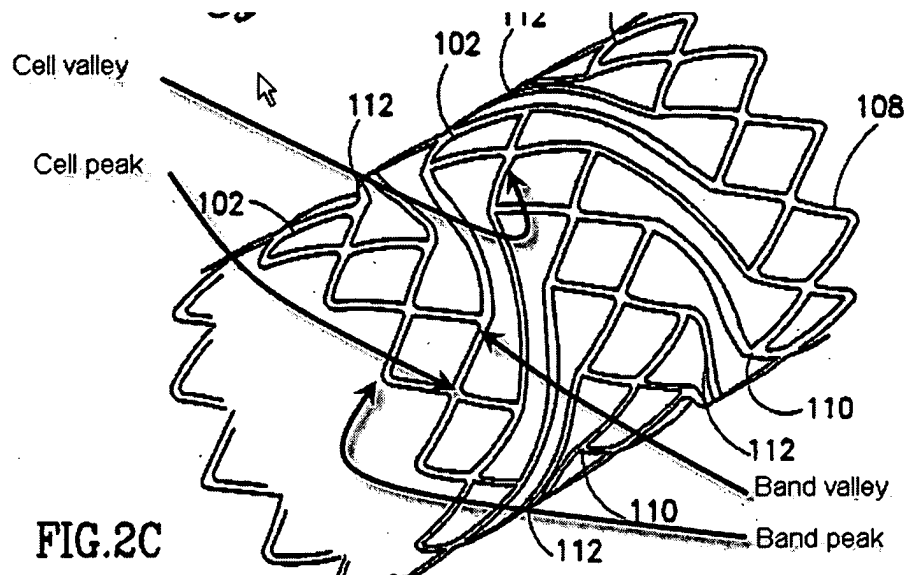
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 20, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinchasik et al (US 5,449,373). Pinchasik anticipates the claim language where the peaks of adjacent ends of the cell are clearly offset; see Figures 2A to 2C. There are serpentine band peaks and valleys and there are cell peaks and valleys; see the figure below.



With regard to claim 20, the shorter bands as claimed are those bands between adjacent diamonds of adjacent serpentine bands; see Figure 2C.

Claims 17, 20, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated over Palmaz et al. (US 5,102,417) in view of Kleshinski (US 5,902,317). Palmaz meets the claim language where the annular elements as claimed are met by the prostheses or grafts (70) of Palmaz and the connectors as claimed are the connectors (100) or spiral members (102) of Palmaz; see Figures 7 to 10 and column 11, line 35 et seq. The cell peaks and valleys are different from the band peaks and valleys as explained in the Pinchasik rejection *supra*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 13, 16, and 21-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchasik et al (US 5,449,373) in view of Kleshinski (US 5,902,317). Pinchasik meets the claim language as explained supra but fails to disclose a "structure" that provides the stent with less compression resistance than provided by the structure of a different annular element. However, Kleshinski teaches that it was known to put fingers on end cells in order to make them less compression resistant than other cells; see Figures 1 to 4 and column 4, lines 3-20. Therefore, it is the Examiner's position that it would have been obvious to put fingers on the ends of the segments for the same reasons that Kleshinski does the same.

Claims 9, 10, 13, 16, and 21-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Palmaz et al (US 5,102,417) in view of Kleshinski (US 5,902,317). Palmaz meets the claim language where the annular elements as claimed are met by the prostheses or grafts (70) of Palmaz and the connectors as claimed are the connectors (100) or spiral members (102) of Palmaz; see Figures 7 to 10 and column 11, line 35 et seq. However, Palmaz fails to disclose a "structure" that provides the stent with less compression resistance than provided by the structure of a different annular element. However, Kleshinski teaches that it was known to put fingers on end cells in order to make them less compression resistant than other cells; see Figures 1 to 4 and column 4, lines 3-20. Therefore, it is the Examiner's position that it would have

been obvious to put fingers on the ends of the segments of Palmaz for the same reasons that Kleshinski does the same.

Claims 14, 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmaz (US 5,102,417) or Pinchasik et al (US 5,449,373) and/or Kleshinski (US 5,902,317) as applied to claims 9, 10, 13, 16, 17, and 20-28 above, and further in view of Lau et al (US 5,514,154). Palmaz or Pinchasik disclose making the stents thereof of various materials but not of Nitinol or shape memory materials as claimed. However, Lau teaches that it was known to make similar stents out of Nitinol (Nitinol is a NiTi alloy with shape memory properties) or shape memory material as an alternative to balloon expandable stents; see column 2, lines 12-56 and the paragraph bridging columns 6 and 7. Therefore, it is the Examiner's position that it would have been obvious to make the stents of Pinchasik or Palmaz out of Nitinol or shape memory material for the same reasons that Lau teaches substituting the same.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is

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not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
Art Unit 3774